

REMARKS

Claims 1-25 remain in the application for consideration. In view of the following remarks amendments and/or remarks, Applicant respectfully requests reconsideration and allowance of the subject application.

The Claim Rejections

Claims 1-25 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,744,472 to MacInnis in view of U.S. Patent No. 6,414,996 to Owen.

Before undertaking a discussion of the substance of the Office's rejections, the following discussion of the §103 Standard is provided.

The §103 Standard

To establish a prima facie case of obviousness, three basic criteria *must* be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Hence, when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of

1 whether there is a teaching, motivation, or suggestion to select and combine the
2 references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin*
3 *Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)
4 ("the central question is whether there is reason to combine [the] references," a
5 question of fact drawing on the Graham factors).

6 "The factual inquiry whether to combine references must be thorough and
7 searching." *Id.* It must be based on objective evidence of record. This precedent
8 has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g.,
9 *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-
10 25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion,
11 teaching, or motivation to combine the prior art references is an 'essential
12 component of an obviousness holding'" (quoting *C.R. Bard, Inc., v. M3 Systems,*
13 *Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re*
14 *Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our
15 case law makes clear that the best defense against the subtle but powerful
16 attraction of a hindsight-based obviousness analysis is rigorous application of the
17 requirement for a showing of the teaching or motivation to combine prior art
18 references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.
19 Cir. 1998) (there must be some motivation, suggestion, or teaching of the
20 desirability of making the specific combination that was made by the applicant); *In*
21 *re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings
22 of references can be combined only if there is some suggestion or incentive to do
23 so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*,
24 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

1 The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217
2 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings
3 must be made as to the reason the skilled artisan, with no knowledge of the
4 claimed invention, would have selected these components for combination in the
5 manner claimed").

6 To support the conclusion that the claimed invention is directed to obvious
7 subject matter, either the references must expressly or impliedly suggest the
8 claimed invention or the examiner must present a convincing line of reasoning as
9 to why the artisan would have found the claimed invention to have been obvious
10 in light of the teachings of the references. See, e.g. *Ex parte Clapp*, 227 USPQ
11 972, 973 (Bd. Pat. App. & Inter. 1985).

12 13 The Claims

14 **Claim 1** recites a method comprising:

- 15
- 16 • receiving a command from a decoder application at an application
program interface (API); and
 - 17 • generating one or more filter control command data structures,
18 recognizable by a communicatively coupled accelerator including
one or more parameters which, when received by the accelerator,
19 affects one or more filter settings of the accelerator based, at least in
part, on the content of the received command.
- 20

21 In making out the rejection of this claim, the Office argues that MacInnis
22 discloses an apparatus that comprises "receiving a command from a decoder
23 application (MacInnis figure 2, item 50, wherein the decoder application is the
24 video decoder)." The Office also argues that the apparatus comprises "generating
25 one or more filter control command structures recognizable by a communicatively

1 coupled accelerator including one or more parameters which effect one or more
2 filter settings of the accelerator (MacInnis: figure 2, column 57, lines 21-37,
3 wherein the filter parameters are the blending, scaling, blitting, and filling, the
4 accelerator is the graphics accelerator)." The Office then acknowledges that
5 MacInnis fails to show an application interface but argues that Owen, in figure 1
6 (navigation manager), teaches that it is well known in the art to include an
7 application program interface with decoder and accelerator systems. Based on
8 this, the Office reasons that it would be obvious to take the apparatus disclosed by
9 MacInnis and implement an application program interface as taught by Owen in
10 order to obtain an apparatus that can operate efficiently.

11 Applicant disagrees with the substance and rationale used by the Office and
12 traverses the rejection. Applicant respectfully submits that the Office has not
13 made *particular findings* as to the reason the claimed subject matter would be
14 obvious in view of the cited references. Simply stating that the combination
15 would "*obtain an apparatus that can operate efficiently*" does not rise to the level
16 of a particular finding.

17 It its previous response, Applicant referenced a paper, provided by the
18 Office itself, which criticized the stated motivation of improving efficiency. As
19 previously demonstrated, the Office's rejection provides a reason for combining
20 the references which is simply too general, and does not address *why* a specific
21 proposed modification would have been obvious. As noted by the Office, "[t]he
22 motivation, improve efficiency, is too general because it could cover almost any
23 alteration".

24 In responding to Applicant's previous arguments that no motivation exists
25 to combine these references, the Office states "the examiner combined MacInnis

1 with Owen to show an interface that would make MacInnis's apparatus more
2 efficient, meaning that, the apparatus now provides a way to easily obtain
3 information from outside sources." Applicant respectfully submits that this
4 reasoning is misplaced. First, the apparatus in MacInnis already obtains
5 information from outside sources, such as video and audio data. (e.g. figures 1
6 and 2 depict "audio in" and "audio out"). Therefore, the stated motivation "*the*
7 *apparatus now provides a way to easily obtain information from outside sources*"
8 is not applicable to MacInnis. Second, Applicant fails to understand how
9 implementing the alleged interface of Owen (navigation manager) would provide a
10 way to easily obtain information from outside sources, or why an artisan would
11 have been motivated to do so. In Owen, the navigation manager simply controls
12 the playing of programs stored on a DVD. A user *inputs* commands to the
13 navigation manager which merely drives the *presentation* engine. (see Owen
14 column 6 , line 66 to column 7, line 10). Thus, even if the navigation manager in
15 Owen was an API, which it is not, it would not "*provide a way to easily obtain*
16 *information from outside sources.*"

17 Perhaps more importantly, this stated motivation *still* merely involves
18 improving efficiency and could be used to justify almost any modification of
19 MacInnis and fails to explain *why* the proposed combination with Owen would
20 have been obvious. As such, the Office has failed to establish a *prima facie* case
21 of obviousness

22 Additionally, Applicant respectfully submits that the Office has
23 mischaracterized the Owen reference. Specifically, figure 1 in Owen depicts a
24 DVD system that includes a navigation manager that controls the playing of
25 programs stored on the DVD by means of user input commands. As figure 1

1 illustrates, the navigation manager 38 does not receive *commands from the*
2 *decoders*, and in fact, only receives *bitstream* information from the tack buffer 34.
3 Thus, even if the navigation manager was an API, which it is not, Owens teaches
4 away from "*including an application program interface with a decoder*" in so far
5 as it shows the navigation manager to be effectively *upstream* of the decoders and
6 unable to receive any commands from them. Accordingly, an artisan would have
7 no motivation to combine such disparate references.

8 In view of the above discussion, the Office's rejection is misplaced and
9 does not establish a *prima facie* case of obviousness. Hence, for at least these
10 reasons, this claim is allowable.

11 **Claims 2-11** depend from claim 1 and are allowable as depending from an
12 allowable base claim. These claims are also allowable for their own recited
13 features which, in combination with those recited in claim 1, are neither disclosed
14 nor taught by the references of record, either singly or in combination with one
15 another

16 **Claim 12** recites a storage medium comprising a plurality of executable
17 instructions which, when executed, implement an application program interface
18 (API) to dynamically generate one or more filter control command data structures
19 in response to a command received from a decoder application, wherein the one or
20 more filter control command data structure(s) include one or more parameters
21 which, when received by a communicatively coupled accelerator, effect one or
22 more filter settings on the accelerator in accordance with the received command.

23 In making out the rejection of this claim, the Office uses the same argument
24 and reasoning as it did in making out the rejection of claim 1. As noted above, the
25

1 Office has failed to establish a *prima facie* case of obviousness. As such, this
2 claim is allowable.

3 Claims 13-17 depend from claim 12 and are allowable as depending from
4 an allowable base claim. These claims are also allowable for their own recited
5 features which, in combination with those recited in claim 12, are neither disclosed
6 nor taught by the references of record, either singly or in combination with one
7 another

8 Claim 18 recites a computing system comprising:

- 9
- 10 • a decoder application to process received media content; and
 - 11 • an operating system including an application program interface
12 (API), support the media processing, wherein the API generates one
13 or more filter control commands including one or more parameters
14 which, when received by a communicatively coupled media
15 processing accelerator, effect one or more filter settings of the
16 accelerator in accordance with a command received from the
17 decoder.

18 In making out the rejection of this claim, the Office uses the same argument
19 and reasoning as it did in making out the rejection of claim 1. As noted above, the
20 Office has failed to establish a *prima facie* case of obviousness. As such, this
21 claim is allowable.

22 Claims 19-25 depend from claim 18 and are allowable as depending from
23 an allowable base claim. These claims are also allowable for their own recited
24 features which, in combination with those recited in claim 18, are neither disclosed
25 nor taught by the references of record, either singly or in combination with one
another

1 **Conclusion**

2 All of the claims are in condition for allowance. Accordingly, Applicant
3 requests a Notice of Allowability be issued forthwith. If the Office's next
4 anticipated action is to be anything other than issuance of a Notice of Allowability,
5 Applicant respectfully requests a telephone call for the purpose of discussing an
6 appeal.

7 Respectfully Submitted,

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